

REMARKS

I. Petition Under 37 C.F.R. §1.137(b)

Pursuant to 37 C.F.R. §1.137(b), applicants petition for revival of this abandoned application including this submission for the final Office Action dated May 19, 2006, as the delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. A petition pursuant to 37 C.F.R. §1.137(b) is transmitted herewith.

Pursuant to 37 C.F.R. § 1.114, applicants petition for a Request for Continued Examination including this submission for the final Office Action dated May 19, 2006. A petition pursuant to 37 C.F.R. § 1.114 is transmitted herewith.

The Commissioner is authorized to charge the fees set forth in 37 C.F.R. § 1.17(e) and 37 C.F.R. § 1.17(m) or any other fees which may be required or credit any overpayment to Deposit Account No. 50-0417.

II. Introduction

Claims 32-70 and 72-78 are pending in this application.

Claims 32-70 and 72-78 are rejected.

New claims 79-103 are presented for examination.

Applicants traverse these rejections based on the amendments above and the remarks set forth below.

Reconsideration and allowance of the pending claims is respectfully requested.

III. Applicants' Reply to Rejection Under 35 U.S.C. §102(b)

Claims 32, 34, 68, and 69 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,855,725 to Fernandez et al. ("Fernandez"). Applicants respectfully traverse.

Fernandez is purportedly concerned with a portable storage device ("CD book"), which stores several pages of content in its RAM and adds new content by transferring data from a CD-ROM database when the user reaches the last page of the previously stored content or requests a page not currently stored on the device. See, e.g., Fernandez, Abstract; column 2, lines 32-38; column 3, lines 8-24; column 7, lines 35-61; Figs. 2, 4, 5.

Claims 32-34

The Examiner has rejected pending claim 32 contending that applicants' recited claim features do not require selecting a playback time, but rather merely specifies a property of data and that Fernandez inherently has a certain playback time based on the user's ability to read a page (pages 3-4 of Office Action, first paragraph).

Applicants respectfully disagree. In the first instance, claim 32 does indeed specify selecting episodes having certain

playback times. For example, claim 32 specifies "automatically selecting a subsequent episode ... wherein the subsequent episode is no greater than a predetermined playback time." Accordingly, applicants' claimed invention examines the playback time of a subsequent episode to determine whether it qualifies for selection. By establishing a playback time threshold and excluding subsequent episodes that exceed that threshold, the invention recited in claim 32 does indeed select episodes having acceptable playback times, and therefore selects episodes based on their playback characteristics. Because applicants' claimed method makes selections based on playback time, the claim does not merely recite a property of the data as the Examiner contends, but rather makes decisions based data characteristics. Thus, claim 32 is allowable over Fernandez.

Moreover, with respect to the Examiner's position regarding inherency based on the user's average time to read a page, applicants submit that this rejection is based on flawed analogies and assumptions. Initially, applicants point out that the system of Fernandez does not have any "playback time" associated with it at all. This is because the electronic book of Fernandez merely displays pages of a book on a video screen (as admitted by the Examiner) and therefore has no playback time associated with it.

On the other hand, applicants' invention is concerned with digital content having an associated playback time (such as audio and/or video content). Because Fernandez merely renders pages of a book on an electronic display screen as prompted by a user, the concept of playback time, or making decisions based on playback time, as specified in applicants' claims, are completely absent. Moreover, the Examiner's point about the average time to read a page is inapplicable for numerous reasons. For example, claim 32 specifies the amount of time it takes to playback certain digital content, which is a function of an electronic device as opposed to the function of a human (*i.e.*, average reading speed of a person). The claim specifies a selection criteria of acceptable certain content, not the reading ability of a user of an electronic book. Further, this position also relies on the assumption that pages of Fernandez contain the same content, which is not the case, and such content variation greatly varies the reading speed of the average user (*e.g.*, a page may contain only a picture, table of contents, 36 point font, 4 point font, *etc.*). Thus, at least for the forgoing reasons, claim 32 is allowable over Fernandez. Claims 33-34 are allowable for at least the same reasons. Lastly, applicants further restate and reiterate the reasons of allowance as set forth in the February 9, 2006 Reply with respect to claims 32-34.

Claims 68-69

Regarding claims 68-69, it appears the Examiner's rejection is based on the correlation of a "page" of the electronic book of Fernandez with the content file specified in claim 68. See Office Action dated May 19, 2006, page 3, second paragraph. Claim 68, as amended, now specifies updating a first content file when a part of the first content file is consumed. Based on the correlation drawn by the Examiner, Fernandez would thus have to be capable of updating a portion of page. However, Fernandez is only capable of updating content on a "page-by-page" basis. See Fernandez, column 7 and Fig. 4. Because Fernandez is incapable of updating a partially consumed page (such as a partially consumed first content file) as specified in claim 68, claims 68 and 69 are allowable over Fernandez. Applicants further restate and reiterate the reasons of allowance as set forth in the February 9, 2006 Reply with respect to claims 68-69.

Accordingly, at least for the above stated reasons, applicants respectfully request that the rejection of claims 32, 34, 68, and 69 under 35 U.S.C. § 102(b) be withdrawn.

IV. Applicants' Reply to Rejection under 35 U.S.C. §103(a)

Claims 33, 40-64, and 70

Claims 33, 40-64, and 70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fernandez. Applicants respectfully traverse.

Applicants submit that claim 33 is allowable for at least the same reasons as independent claim 32, as explained above.

Furthermore, the Examiner has maintained the rejection of claims 40, 46, 52, 57 and 70 contending that the claims fail to specify where the titles are stored and that the claims require storing only one, not multiple titles. See Office Action, page 4, first full paragraph. However, in the February 9, 2006 Reply, at pages 5-6, applicants pointed out that Fernandez does not show or suggest replacing consumed media according to a user predetermined specification as recited in these claims. In that Reply, applicants further established that any design choice described in Fernandez relates to system limitations such as transmission rates and processing speed, and thus relate to configuration choices made by a system designer, not a user. The Examiner has not responded to, or even acknowledged this argument in the most recent Office Action. Accordingly, applicants' respectfully submit that claims 40, 46, 52, 57 and 70 are allowable over Fernandez for at least this reason. The

foregoing notwithstanding, applicants have amended claims 40, 46 and 52 to make clear the claim is concerned with multiple titles and not just one title. Applicants further restate and reiterate the reasons of allowance as set forth in the February 9, 2006 Reply with respect to these claims.

Thus, for at least the above stated reasons, applicants respectfully request that the rejection of claims 32, 34, 68, and 69 under 35 U.S.C. §103(a) be withdrawn.

Claims 35-39

Claims 35-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent No. 5,761,485 to Munyan ("Munyan") in view of U.S. Patent No. 5,918,013 to Mighdoll et. al ("Mighdoll") and U.S. Patent No. 5,491,820 to Belove et. al ("Belove"). Applicants respectfully traverse.

Claim 35 specifies, among other things:

"a playback device to store and to playback the digital content coupled with the data retrieval device, the playback device to store a most-recent episode of a dynamically changing series of digital content, and to have the digital content automatically updated from the server device with a subsequent episode of the series of digital content to store on the playback device."

Neither Belove, Mighdoll nor Munyan, alone or in combination show or suggest these features.

For example, the Examiner contends that Munyan teaches a server to store and provide digital content and a playback device to store and play digital content. See August 12, 2005 Office Action, page 7. The Examiner further contends that Mighdoll shows a retrieval device which retrieves content on behalf of user devices and that the retrieval device automatically updates its content. *Id.*

However, in the system of Mighdoll, the updated content is stored on the intermediate retrieval device (proxy cache 65 on server 5) *and not on the playback device* as specified in applicants' claims. See Mighdoll, column 11, line 50 to column 12 line 9; and column 4, line 40 to column 5, line 27 which explains that the purpose of updating the cache of potentially updated web pages is to reduce latency, help prevent propagation of outdated information from cache 65 to a system requesting information for the first time and ensure compatibility with the client's system. This has nothing at all to do with updating content in a playback device with a subsequent episode, but rather a network management tool. Accordingly, any updates are not on the playback device as specified in applicant's claims. Consequently, claims 35-39 are allowable over Munyan and Mighdoll.

The Examiner's proposed combination of Belove and Munyan suffers from similar deficiencies. For example, the Examiner



contends that Belove stores a most-recent episode of a dynamically changing series of digital content, and to have the digital content automatically updated from the server device with a subsequent episode of the series of digital content to store on the playback device. Applicants disagree. Belove explains that a user may select a folder of content and the system may issue a List Delta request which provides certain lists useful for updating the contents of the content folder based on a specific update time provided by the client. See Belove, column 10, line 50 to column 11, line 17.

Once the content file is downloaded, however, another subsequent user initiated request is required to receive any subsequent updates to those content files. In contrast, applicants claimed invention specifies *automatically* updating from the server with a subsequent episode. With the system of Belove, the user must again and again manually request the content folder in order to receive the benefit of another List Delta request. Once the content folder is received no further updates occur, whereas in applicants' claimed invention, updates of subsequent episodes are provided automatically without the need to request for the same content again. As a result, claims 35-39 are allowable over the proposed combination of Munyan and Belove. Applicants further restate and reiterate the reasons of allowance as set forth in the February 9, 2006 Reply.

Accordingly, in view of the foregoing, applicants submit that claims 35-39 are patentable over the Examiner's proposed combination Mighdoll, Munyan, and Belove and respectfully request that the rejection of claims 35-39 under 35 U.S.C. §103(a) be withdrawn.

Claims 65-67 and 72-78

Claims 65-67 and 72-78 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,442,390 to Hooper et al. ("Hooper"). Applicants respectfully traverse.

Hooper is purportedly concerned with a video-on-demand system, in which a selected video is transferred as video segments and stored in a memory buffer ("segment cache"), which includes a write pointer ("fill pointer") and a read pointer ("play pointer"). See, e.g., Abstract; column 2, lines 1-7; column 9, lines 45-48. The total number of video segments stored in the cache is fixed and depends on the type of video, but all segments are from a single video. *Id.*, column 10, lines 9-29.

In contrast, independent claims 65 and 75 specify a playback device including memory to store multiple digital content selections, logic to maintain a head pointer identifying a logical beginning of each selection in memory, and a content counter. Furthermore, Hooper does not store multiple content selections; at most, it stores several adjacent segments of the

same video. Completely absent from Hooper is any teaching or suggestion on how to store or render segments relating to different content selections in the same segment cache. In fact, such features are not suggested or even recognized as desirable. Thus, the single video caching system of Hooper teaches away from systems including plurality of different content selection as specified in applicants' claims.

The Examiner asserts that "it is well known in the art to provide device with multitasking capability or to let a view seeing two or more TV channels at a time." See Office Action date May 19, 2006, page 5. However, Hooper does not provide any teaching on how to accomplish this significant proposed modification. Nor does the Examiner provide another reference which teaches how to accomplish the proposed modification. Such a modification may require additional hardware, software, data management protocols or procedures as well as additional controller(s) and corresponding logic to effect a content counter, discouraging the proposed combination. Hooper does not show or suggest how to effect any such modifications. Moreover, a mere assertion that the modifications or the prior art necessary to meet the claimed invention were separately known to one skilled in the art at the time the invention was made is insufficient to support a finding of obviousness. See *Ex parte Levengood*, 28 U.S.P.Q.2dc 1300 (Bd. Pat. App. & Inter. 1993).

Applicants further restate and reiterate the reasons of for allowance over Hooper as set forth in the February 9, 2006 Reply. Accordingly, applicants respectfully submit that claims 65-67 and 72-78 are patentable over Hooper.

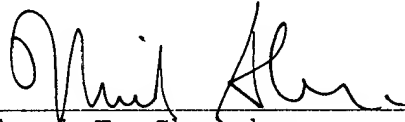
V. Conclusion

For the foregoing reasons, applicants respectfully submit that the invention as claimed is patentable. Accordingly, reconsideration and allowance of pending claims 32-70, 72-78 and new claims 79-103 are respectfully requested. The Examiner is encouraged to contact applicants' undersigned representative to discuss any matter that may expedite prosecution of this case.

Date: \_\_\_\_\_

4/9/08

Respectfully submitted,



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